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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,132	12/20/2001	Stuart T. Gordon	82142SMR	2406

7590 02/19/2003
Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

6

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary	Application No.		Applicant(s)	
	10/028,132		GORDON ET AL.	
	Examiner		Art Unit	
	Hoa V. Le		1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 with respect to the applied and elected species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>02</u> . | 6) <input type="checkbox"/> Other: _____ |

This is in response to the election filed on 27 January 2003.

I. Applicants elect E-2 species being acknowledged. The E-2 species has been considered and searched. The consideration and search are extended to the applied species. Other non-elected species have not been considered, searched or examined until all of the applied species are overcome.

II. The first independent claim 1 is considered as the main invention. Claims 2-23 are considered as the secondary embodiments and permitted to be rejoined with the main invention of the independent claim 1 when it found to be allowable.

III. (1) It is allowed to claim by a functional, characteristic or chemical property of a material (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic or chemical property of a material carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it for his own benefit. Please also see In re Schreiber, 44 USPQ2d 1432 since it is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional or characteristic properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. For example, the language "CAR is a carrier moiety...with oxidized developing agent", "ETA is a releasable...the pyrazolidinone ring" or the like has been considered as a functional, characteristic and chemical properties of a material.

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II. Applicants' prior art submission filed on 20 December 2001 has been considered.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(A) Claims 1-23 with respect to the applied and elected E-2 species are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (5,605,786 as submitted) alone or with Lunt et al (6,110,657 as submitted).

Saito et al disclose, teach, suggest, demonstrate and reduce to practice with a method for a color development of a photosensitive silver bromiodide photographic material in less than 200 seconds; wherein a dye-forming unit containing a compound being read on the general formula as claimed being close to a support of the photographic material. Please see the whole disclosure of each of the applied references, especially in Saito et al at compounds (1) to (36) and Examples 1 and 2. Since Saito et al disclose, teach, suggest, demonstrate and reduce to practice the essential and main embodiments of the claimed invention, claims 1-23 are found to be rendered prima facie obvious by Saito et al alone. Lunt et al compound E-2, which is the same as that elected species of the record, and its equivalent compounds E(1 and 3-17) and C(1-3) are applied in a dye-forming unit being close to a support of a photosensitive silver bromiodide photographic material. Please also especially in Lunt et al at Examples. Since the above references are related to the related compounds being applied in a dye-forming unit which is close to the support of a photosensitive silver bromiodide photographic material and a color

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developing process in less than 200 seconds as claimed, it would have being obvious to one having ordinary skill in the art at the time the invention was made to apply or use the related compound from Lunt et al as those disclosed, taught, suggested, demonstrated and reduced to practiced to obtained the same or substantially the same result as disclosed, taught, suggested, demonstrated, reduced to practices and obtained in Saito et al. The showings in the Examples of the instant application have been considered but are insufficient and much more broader than those being drawn in the claims. The language "less than" or no amount of the requisite chemical ingredients in the claims is included and has been considered near to zero, such as: 0.000 000 001 msec (milliseconds) or 0.000 000 001 mg. It would like to see a result of the claims as broadly drawn at this tiny amount for the patentability of the claims. In the absence of convincing evidence, any advantage as urged alone is a supposition. Applicants should show an evidence to the contrary for the record for the patentability of the claims.

(B) (A) Claims 1-23 with respect to the applied and elected E-2 species are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai et al (5,830,627 as submitted) alone or with Lunt et al (6,110,657 as submitted).

Nakai et al disclose, teach, suggest, demonstrate and reduce to practice with a method for a color development of a photosensitive silver bromiodide photographic material in less than 200 seconds; wherein a dye-forming unit containing a compound being read on the general formula as claimed being close to a support of the photographic material. Please see the whole disclosure of each of the applied references, especially in Nakai et al at compounds 1-9, 12, 25-27, 29-41, 43-48, 53, 57 and 64, col.79:23 to 81:14 and Examples. Since Nakai et al disclose,

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teach, suggest, demonstrate and reduce to practice the essential and main embodiments of the claimed invention, claims 1-23 are found to be rendered prima facie obvious by Nakai et al alone. Lunt et al compound E-2, which is the same as that elected species of the record, and its equivalent compounds E(1 and 3-17) and C(1-3) are applied in a dye-forming unit being close to a support of a photosensitive silver bromiodide photographic material. Please also especially in Lunt et al at Examples. Since the above references are related to the related compounds being applied in a dye-forming unit which is close to the support of a photosensitive silver bromiodide photographic material and a color developing process in less than 200 seconds as claimed, it would have being obvious to one having ordinary skill in the art at the time the invention was made to apply or use the related compound from Lunt et al as those disclosed, taught, suggested, demonstrated and reduced to practiced to obtained the same or substantially the same result as disclosed, taught, suggested, demonstrated, reduced to practices and obtained in Nakai et al. The showings in the Examples of the instant application have been considered but are insufficient and much more broader than those being drawn in the claims. The language "less than" or no amount of the requisite chemical ingredients in the claims is included and has been considered near to zero, such as: 0.000 000 001 msec (milliseconds) or 0.000 000 001 mg. It would like to see a result of the claims as broadly drawn at this tiny amount for the patentability of the claims. In the absence of convincing evidence, any advantage as urged alone is a supposition. Applicants should show an evidence to the contrary for the record for the patentability of the claims.

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IV. The counsel for Eastman Kodak Comp. usually does not follow up and up to date the missing information in an application. Please provide the missing information on page 45, line 21 of the instant application to fulfill the record.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
February 14, 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le